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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/207,954 12/09/98 YEH

Y 733-003

EXAMINER

TM02/1109

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ALVAREZ, R

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

11/09/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/207,954

Applicant(s)
Yeh et al.

Examiner
RAQUEL ALVAREZ

Group Art Unit
2162



☒ Responsive to communication(s) filed on Dec 9, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-44 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 35-37 is/are allowed.

☒ Claim(s) 1-34 and 38-44 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited/PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Claims 1-44 are presented for examination.
2. This office action is in response to the amendment filed on 8/28/2000.
3. This office action is a non-final action.

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al. (5,974,398, hereinafter Hanson) in view of DeLapa et al. (6,076,068 hereinafter DeLapa).

With respect to claims 14 and 31, Hanson teaches receiving via Internet demographic information corresponding to a subscriber(col. 2, lines 55-, col. 3, lines 1-4 and col. 4, lines 54-60); a storage space, said storage space configured to store a message (database 108); delivering to said subscriber a marketing message(Figure 3).

Hanson teaches a customer profile database(102) that contains demographic information about the subscriber such as the age, gender, marital residence, residence, etc. and also Hanson teaches storing marketing messages. Hanson does not specifically teach storing a personal message for a

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particular customer. On the other hand, DeLapa teaches storing specific messages for specific customers based on their demographics and prior purchasing habits(Abstract). It would therefore have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have modified the marketing messages of Hanson with personalized messages to the subscriber because such a modification would increase the customer's attention to the advertisement.

With respect to claims 15, 16, 32 and 33, Hanson teaches assigning to said subscriber a telephone number and an e-mail address corresponding to said storage space such that said personal message corresponds to a voice message(i.e. the customer can consent to receive a sales call by telephone so that a personalized message based on that customer's demographic can be delivered to the customer)(col. 5, lines 50-, col. 6, lines 1-5); receiving said message via telephone or e-mail (i.e. the message can be supplied by telephone); storing said voice message in said storage space(col. 5, lines 3-21); and retrieving said voice message or e-mail from said storage space(col. 5, lines 3-21). Hanson does not specifically teach that the retrieving of the voice message or e-mail is prior to the delivering step nevertheless it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included retrieving the voice message prior to having the marketing message that corresponds to the customer demographic information delivered because such a modification would notified the customer that a personalized message would be forthcoming.

Claims 17 and 34 further recite assigning a password corresponding to said storage space and delivering said messages to the subscriber if the password corresponds. Hanson further

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teaches a database wherein service issues such as security, passwords, and the like is stored(col. 4, lines 54-60) therefore it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included having the customer use the passwords before the delivery of the messages because such a modification would provide security(col. 4, lines 54-60).

6. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over publication, titled, Mendler "Competition drives operators toward retail innovation" hereinafter Mendler.

With respect to claim 35, Mendler teaches receiving a telephone call from a caller(i.e. the customer calls an MCI operator and provide the numbers of their closest friends)(page 3, paragraph 5); querying said caller for a third-party telephone number(page 3, paragraph 5); receiving said third-party telephone number(i.e. the operator receives the third-party telephone numbers to enable the customer to receive discounts calls on those specified numbers)(page 3, paragraphs 4-5).

With respect to initiating a telephone call between said caller and the third party and delivering to said caller and said third party a marketing message during said telephone conference call. Since, the MCI system is partly responsible for taking 5 percent of AT&T's market share(page 3, paragraph 4) and since it is well known to place conference calls that deliver marketing messages. For example, mortgage companies would call the individuals responsible for decision making by conference calls to deliver marketing message that would motivate both parties to agree on certain specifics of a proposed deal or contract. It would have been obvious to a person of

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ordinary skill in the art at the time of Applicant's invention to have included delivering a conference marketing message to the friends and family of the customer because such a modification would save time by enabling the MCI operators to deliver the same message to the two parties at the same time.

Claim 36 differs from claim 35 in that it further recites receiving a call from a caller having a calling card, said calling card having a predetermined number of minute credits associated with it. Official notice is taken that is old and well known for callers to place phone calls with calling cards said calling cards have a predetermined number of minutes based on the money amount purchased. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a calling card because such a modification would enable the caller to prepay for the call ahead of time.

Claim 37 further recites adding an additional number of minutes credits to said calling card when said marketing message is delivered. Official notice is taken that is old and well known to credit or pay customers for their attention to advertisements. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included adding a credit to said calling cards when said marketing message is delivered because such a modification would motivate the customers to listen to the message.

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7. Claims 1, 4, 5, 11, 12, 18, 21, 22, 28-30, 41 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann et al. (5,933,778 hereinafter Buhrmann) in view of Civanlar (EP 0 732 835 A 2 hereinafter Civanlar).

With respect to claims 1, 4, 5, 11, 12, 18, 21, 22, 28-30, Buhrmann teaches receiving a time, a date and telephone number for a reminder telephone call(col. 11, lines 34-66); storing in a database said time, date and telephone number of said reminder telephone call(i.e. the alert processor scans the subscriber profile stored in the database to obtain the alert message information, such at the time that the alert message is to be delivered, the date and the telephone number that the alert message is to be delivered to)(col. 11, lines 34-66); and delivering said reminder telephone call at said specified time, date and telephone number(i.e. the alert message(reminder message) is sent to its destination)(col. 11, lines 34-, col. 7, lines 1-17).

Buhrmann does not specifically teach that the message receive is associated with a product or service provider but,since, Buhrmann teaches that the system maintains a subscriber profile database(118) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using the subscriber profile database to generate a message associated with a product or service provider of interest to the subscriber.

Buhrmann teaches delivering the message over telephone. Buhrmann does not specifically teach that the step of receiving the information is via the Internet. On the other hand, Civanlar teaches providing a client-server architecture utilizing the Internet and public switched networks wherein it receives the client information over the Internet connection and handles the client's

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request by using the telephone number provided by the client(col. 6, lines 34-, col. 7, lines 1-7). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving the information via the Internet and delivering the service over the telephone because such a modification would guarantee quality of service, security, and easy and flexible mechanism to charge for the information and transmission services which are all expected from a complete information network(col. 1, lines 20-25).

With respect to claims 38 and 41, the claims differ from claim 1 in that it further recites delivery of an e-mail reminder telephone call. Official notice is taken that is old and well known to send mail(e-mail) message to remind patients to call the doctor's offices to schedule yearly routine check ups. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving via the Buhrmann management system an e-mail reminder telephone call because such a modification would allow the subscriber to open the e-mail at a time that is convenient for him or her.

With respect to claims 42 and 43, the claims further recite receiving from a subscriber a name and a topic. Official notice is taken that is old and well known for e-mail to contain the name of the sender along with the topic of the message. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a name and a topic for the specific e-mail message because such a modification would allow the receiver to know who the sender is and what the message is about before the message is open.

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With respect to claims 9, 26 and 44, the claim further recites receiving from the subscriber a specifiable number corresponding to a number of e-mail messages. Since, in Buhrmann the subscriber can specify the number of alert messages that he or she wants to receive at a specified time period specified by the customer(col. 11, lines 34-, col. 12, lines 1-17). If the receiving step was to be performed by e-mail then it would have been obvious to a person of ordinary skill in the art at the time of the Applicant's invention to have included an specifiable number corresponding to the number of message that the customer is to received to obtain the benefits above mentioned.

8. Claims 2, 3, 6-8, 10, 19, 20, 23, 24, 25, 27, 39, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann et al. (5,933,778 hereinafter Buhrmann) in view of Civanlar (EP 0 732 835 A 2 hereinafter Civanlar) further in view of Hanson et al.(5,974,398 hereinafter Hanson).

With respect to claims 2, 19 and 39, Buhrmann further teach that the telephone call further comprises a message(col. 11, lines 29-, col. 12, lines 1-17). The combination of Buhrmann and Civanlar does not specifically teach that the message is a marketing message. On the other hand, Hanson teaches sending marketing message to the subscriber based on the customer's interest profiles and service usage(Abstract). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included including modifying the message of Buhrmann with marketing message because such a modification would provide a more productive message that the customer most likely be interested in.

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With respect to claims 3, 20 and 40, the combination of Buhrmann and Civanlar further teach receiving via the Internet information corresponding to a subscriber and delivering the message during a reminder telephone call. The combination of Buhrmann do not specifically teach that the information is demographic information and matching the marketing message to the demographic information. On the other hand, Hanson teaches obtaining demographic information to enable marketing message to be delivered based on the particular client's demographic (Figures 1-15). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included obtaining demographic information and using the demographic information to market the messages because such a modification would provide a more productive message that the customer most likely be interested in.

With respect to claims 6 and 23, Hanson further teaches that the information is selected from a group consisting of news and information (col. 3, lines 13-24). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the information selected from a group consisting of news and information because such a modification would provide a variety of information available to the client based on their interests and likes.

With respect to claims 7 and 24, Hanson further teaches receiving a signal from the subscriber during the delivery of the corresponding marketing message and delivering to said subscriber additional information corresponding to said marketing message (i.e. in response to the user having selected one of several advertisers, a corresponding message with additional

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information on the selected message is retrieved and delivered to the customer)(col. 10, lines 53-, col. 11, lines 1-5). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included additional information corresponding to the marketing message in response to receiving a signal from the customer because such a modification would help better target the advertisement based on the particular customer tastes and likes.

Claims 8 and 25 further recites that the signal is generated by pressing a button on the telephone. Since, in Buhrmann the delivery of the messages is via a telephone then it would have been obvious to press a button on the telephone to receive the user's selections.

With respect to claims 10 and 27, Hanson further teaches that the additional information comprises a hyperlink text(col. Col. 10, lines 53-65). It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to have included supplying the additional information via a hyperlink text because such a modification would provide easier access to the additional information.

Conclusion

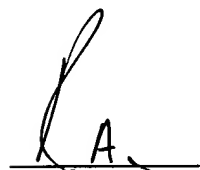
9. The Examiner has found prior art on previously allowed claims 35-37 and therefore this office action is non-final. Please note that the grounds of rejections of claims 14 and 31 have been changed from a 102 rejection to a 103 rejection.

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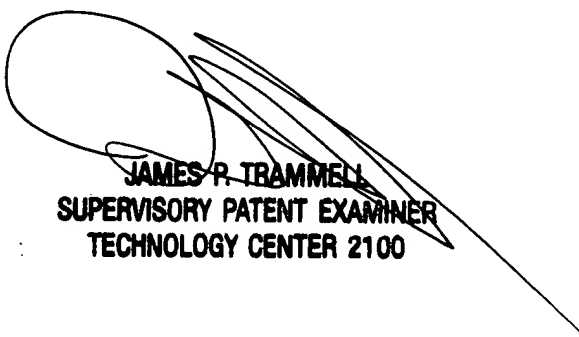
Points Of Contact

10. Any inquiry concerning this communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703) 305-0456. The examiner can normally be reached on Monday to Friday from 9:00 AM. To 5:00 PM.

If any attempt to reach the examiner by telephone is unsuccessful, The examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for this group is (703) 305-0040.



Raquel Alvarez
Patent Examiner, AU 2761
November 5, 2000



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

ATTACHMENT TO AND MODIFICATION OF
NOTICE OF ALLOWABILITY (PTO-37)
(November, 2000)

NO EXTENSIONS OF TIME ARE PERMITTED TO FILE CORRECTED OR FORMAL DRAWINGS, OR A SUBSTITUTE OATH OR DECLARATION, notwithstanding any indication to the contrary in the attached Notice of Allowability (PTO-37).

If the following language appears on the attached Notice of Allowability, the portion lined through below is of no force and effect and is to be ignored¹:

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to comply will result in ABANDONMENT of this application. ~~Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).~~

Similar language appearing in any attachments to the Notice of Allowability, such as in an Examiner's Amendment/Comment or in a Notice of Draftperson's Patent Drawing Review, PTO-948, is also to be ignored.

¹ The language which is crossed out is contrary to amended 37 CFR 1.85(c) and 1.136. See "Changes to Implement the Patent Business Goals", 65 Fed. Reg. 54603, 54629, 54641, 54670, 54674 (September 8, 2000), 1238 Off. Gaz. Pat. Office 77, 99, 110, 135, 139 (September 19, 2000).